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Paper No.

In re application of  
Masao Kamiguchi et al.  
Serial No. 08/154,126  
Filed: November 18, 1993  
For: PRESSURE WAVEFORM SETTING METHOD  
FOR INJECTION PRESSURE CONTROL AND  
AN INJECTION MOLDING MACHINE

DECISION ON  
PETITION

This is a decision on the PETITION TO WITHDRAW HOLDING OF ABANDONMENT, originally filed May 15, 2001. Petitioner has also requested a confirmation whether the records of the U.S. PTO reflect a second FWC application filed December 10, 1997.

**DECISION**

Since petitioner asserts that the Office action was never received, the request qualifies as a petition under 37 C.F.R. 1.181 (no fee).

The requirements for granting a withdrawal of holding of abandonment are set forth as follows:

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement

Additionally, the MPEP sets forth:

37 CFR 1.181(f) provides that, inter alia, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f).

Regarding late submissions under this section the MPEP states:

Rather than dismiss an untimely petition to withdraw the holding of abandonment under 37 CFR 1.181(f), the Office may treat an untimely petition to withdraw the holding of abandonment on its merits on the condition that, in any design application, any utility application filed before June 8, 1995, or any plant application filed before June 8, 1995, the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period between the mail date of the notice of abandonment and the filing date of such petition to withdraw the holding of abandonment. See 37 CFR 1.183 (the Office may suspend or waive the requirements of 37 CFR 1.181(f), subject to such other requirements as may be imposed). The Office may treat an untimely petition to withdraw the holding of abandonment on its merits in a utility or plant application filed on or after June 8, 1995, on the condition that the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon that would extend beyond the date 20 years from the filing date of the application, or the earliest application to which the application specifically refers under 35 U.S.C. 120, 121, or 365(c). In either case, the terminal disclaimer must also apply to any patent granted on any application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c).

A review of the petitioner's evidence indicates that the request has merit. A final office action was issued February 9, 1996 for application 08/154,126. Claims 4-8 were allowed and claims 1-3 and 9-12 were rejected. A Notice of Appeal and Petition and Fee for Extension of time were filed August 16, 1996. A request for Reconsideration under 37 CFR 1.116 was also filed August 16, 1996. The Examiner issued an Advisory Action on August 29, 1996 maintaining the rejection of claims 1-3 and 9-12. An Examiner Interview Summary Record issued on June 19, 1997 referring to an interview on April 2, 1997 indicates that applicants were going to file a FWC with a four-month extension of time on December 10, 1997. Applicants have been unable to locate the second FWC referred to in the Interview Summary Record. Further a search of file does not show any papers for a FWC. A notice of defective notice of appeal or defective brief issued on June 19, 1997. The appeal was dismissed because the brief was not filed and the application was abandoned since a second FWC was to be filed. Applicants have request a withdraw of the holding of abandonment advising that the application should be passed to issuance under M.P.E.P. section 1215.04 since claims 4-8 had been allowed. Applicants have provided copies of their docketing department records that reflect entry of information regarding a February 10, 1997 filing. However applicants cannot locate a date-stamped postcard, a signed copy of the FWC request or any corresponding cancelled check. Applicant concludes that no FWC request was filed notwithstanding the existence of the documents mentioned above.

If no brief is filed within the time prescribed by 37 CFR 1.192, the appeal stands dismissed by operation of the rule. Form PTOL-461 "Notification of Defective Notice of Appeal or Defective Brief," or form paragraph 12.17 notifying the appellant that the appeal stands dismissed is not an action in the case and does not start any period for reply. If no claims stand allowed, an application is considered as abandoned on the date the brief was due. If claims stand allowed in an application, the failure to file a brief and consequent dismissal of the appeal is to be treated as a withdrawal of the appeal and of any claim not standing allowed. The application should be passed to issue forthwith. Unless appellant specifically withdraws the appeal as to rejected claims, the appeal should not be dismissed until the extended period (5 months under 37 CFR 1.136(a)) to file the brief has expired

The Examiner was notified that an FWC was going to be filed by applicants' representative via an interview. Applicant did not notify the Examiner that the FWC was not filed until the filing of the petition on May 15, 2001, which is close to four years from the last correspondence, to the Examiner. 37 CFR 1.181(f) provides that, *inter alia, except* as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment not filed within 2 months of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f).

Therefore, the Petition is **DISMISSED**.

A submission of a terminal disclaimer would overcome the condition for granting an untimely petition to withdraw the holding of abandonment.



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